

Abuyama discloses each and every feature recited in independent claim 14, but for an image multiplier for automatically determining a location of an original portion of an input document containing image data. To overcome these admitted deficiencies, the Office Action again combines the teachings of Suzuki.

Specifically, it is alleged in the Office Action that the CPU 417 shown in Figs. 11 and 14A and described at col. 8, lines 31-65 of Suzuki corresponds to an image multiplier for automatically determining a location of an original portion as recited in the claims. As clearly shown in Fig. 11 of Suzuki, and described in the corresponding text at col. 8, lines 34-49, the position of a banknote, or document, on the platen of a scanner is detected by four corners A, B, C, D. Thus, rather than showing an image multiplier for automatically scanning an original image portion of a document and automatically determining a number of times image portion may be formed on a substrate, Fig. 11 and the corresponding text merely describes scanning the entire document or banknote to determine the position of the document on the platen by the corners A, B, C, D.

The Office Action further relies on Fig. 14A and the accompanying description at col. 8, lines 31-65, as allegedly showing the recited feature. Col. 8, lines 31-65 specifically recites that the CPU 417 detects the exact position and angle of the banknote from a scanned bitmap. The referenced section of Suzuki also recites that the position of a red stamp mark is determined from the obtained position and angle. The red stamp mark is described as an identifying stamp that appears on the 10,000 yen bill of Japanese currency. The detection of such a stamp on the Japanese yen is used to indicate the possibility of forgery and executing a step for preventing such forgery using the image reading and processing apparatus of Suzuki. Specifically, when such a stamp is detected, a signal FF_H is sent to the printer unit and a black toner is deposited over the entire surface of the reproduced image of the currency thereby

disabling proper copying of the 10,000 yen bill to prevent forgery (see col. 9, lines 11-30).

Thus, rather than teaching an image multiplier for automatically scanning an original image portion and automatically determining the number of times the image portion may be formed on a substrate, the CPU 417 and the accompanying components seek to prevent copying.

Thus, the entire intent of Suzuki is contrary to that of the subject matter of this application. Therefore, there can be no motivation or suggestion in the applied reference of Suzuki to make the combination as proposed in the Office Action.

As pointed out in the response to the previous Office Action, in making an assessment of the differences between the prior art and the claimed subject matter, §103 specifically requires consideration of the claimed invention "as a whole." The "as a whole" instruction is intended to prevent evaluation of an invention on a part-by-part basis. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. This line of reasoning has been held to import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. *In re Ruiz v. A.B. Chance Co.*, 357 F.2d 1270, 1275 (Fed. Cir. 2004).

Moreover, Suzuki actually teaches away from determining a number of times an image may be formed on a substrate because it teaches how to prevent an image from being copied at all. As set forth in MPEP §2141.02, the prior art must be considered as a whole, including portions that teach away from the claimed invention. Thus, merely choosing to select a CPU 417 for its alleged teaching of automatically determining a location of an original portion is improper without consideration of the entire Suzuki document as a whole.

Moreover, to modify Abuyama with the teachings allegedly comprised in the CPU 417 of Suzuki would render Abuyama unsatisfactory for its intended purpose. Abuyama

relates to acknowledging to an operator of an image reproduction device, the available number of duplicated images which an apparatus can produce on a given sheet. By combining the teachings of Suzuki, i.e. preventing duplication, the modified device of Abuyama would be rendered unsatisfactory for its intended purpose. Thus, there can be no suggestion or motivation to make the combination as proposed in the Office Action.

In the Response to Arguments, set forth beginning at page 7 of the current Office Action, the Response indicates that "the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. This reasoning is alleged to be supported *In re Fine*, 837 F.2d. 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d. 347, 21 USPQ2d 1941 (Fed. Cir. 1992). However, reliance on *In re Fine* and *In re Jones* is unfounded as in each of those cases, the Examiner and the Board were overturned by the Court which held that there was no support or explanation of the conclusion of obviousness and no suggestion to combine the references to arrive at the claimed invention (see MPEP §2143.01(I)).

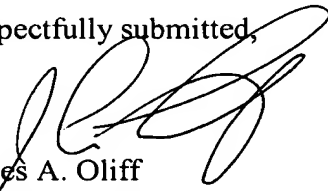
As there is no suggestion or motivation to make the combination as alleged in the Office Action, and further even were such a combination made, would the combination of references disclose or suggest each and every feature recited in the rejected claims, withdrawal of the rejection of claims 1, 2 and 4-18 under 35 U.S.C. §103(a) is respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 2 and 4-18 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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